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10/697,256	10/31/2003	Kazuo Okada	SHO-0054	9221

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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,256	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/18/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the amendment filed on May 8, 2007. The Examiner acknowledges that claims 13-16 are canceled, claim 17 is amended, and claims 18-22 are newly added. Therefore, claims 17-22 are currently pending.

Claim Objections

Claim 21 is objected to because of the following informalities: There appears to be at least two typographical errors in the claim. "A special gain control device" should be --A special games control device-- and "providing a special games stay under" should be --providing a special games state under--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa (JP Publication No. 2000-300729). The English translation of abstract, detailed description, and claims was provided with a previous action.

Claim 17: Nishikawa discloses the invention substantially as claimed including a variable display device for variably displaying various symbols (gaming reels or drums) and a lottery device for executing a lottery of a prize-winning combination (random number generator to

generate a random gaming outcome). Nishikawa in essence also discloses a device for shielding/shuttering and displaying attraction images, where a "game controller", which may also be considered "an attraction control device", controls the device to become one of a transmissive state such that a symbol on the variable display device is visually recognizable and a shielding state such that a symbol on the variable display device is not visually recognizable.

Nishikawa, however, fails to explicitly disclose that such tasks are performed by two separate device, specifically, a shielding device for shielding approximately the whole area of the variable display device, the shielding device being disposed in front of the variable display device, and an attraction display device for displaying an attraction image, the attraction displayed being disposed in front of the shielding device.

Regardless of such a deficiency, it would have been obvious to one of ordinary skill at the time of the invention using two rationales either separately or combined to have modified Nishikawa in such a way to arrive at the claimed invention.

First, the Applicant is directed to *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) [see also MPEP 2144.04, section V, part C]. Summary of *In re Dulberg*: "The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is 'press fitted' and therefore not manually removable." The court held that "if it were considered desirable for any reason to obtain access to the end of the prior art's holder to which the cap is applied, it would be obvious to make the cap removable for that purpose." The Examiner submits the same logic is applicable to the instant case, in which it appears the Applicant, in the most recent remarks filed May 8, 2007, discloses that the prior art of Nishikawa provides a similar invention, with the simple

difference that Nishikawa performs two tasks with a single device (i.e. the transparent liquid crystal display performs both shielding and displaying of attraction images) and the instant application claims the same two tasks performed by two separate devices. Therefore, if it were desirable for any reason to perform such tasks by two separate devices, it would be obvious to one of ordinary skill in the art to use two separate devices for such a reason (i.e. the Applicant discloses that in Nishikawa it is difficult to display images effectively if both tasks are performed by a single device). For the purposes of patentability, making a single device separable into two devices is not patentably distinct. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to make the disclosed single display device separable into two devices effectively producing a shutter or shielding device and a separate image attraction display device for at least the reason that it may have been desirable to one of ordinary skill in the art.

Alternatively, or even in combination with (i.e. one may duplicate two parts to make them perform separable tasks), the Applicant is directed to *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) [see also MPEP 2144.04, section VI, part B]. Summary of *In re Harza*: The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Thus, the Examiner submits that duplicating Nishikawa's display that is disposed in front of the reels would have required only routine skill in the art. Once duplicated, one device is capable of being used as an electronic shutter, while the other is usable as an image attraction device. Nishikawa's attraction control device (i.e. the game controller) is thus usable to control both devices based on applied voltages. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to duplicate the display device component.

For at least these reasons, the claimed invention is considered obvious in view of Nishikawa.

Claims 18 & 19: Nishikawa's liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols via a colored or opaque state and enables visibility via a transmissive or semi-transmissive state. Additionally, as discussed above, it would have been obvious to make that separate electronic shutter device specifically for shielding.

Claim 20: As is the nature of electronic shutter devices (i.e. transparent liquid crystal displays), the shielding state being opaque and transparent is controlled by way of an applied voltage (figure 2).

Claim 21: As discussed before and now inclusive within the established separable tasks of shielding and displaying attraction images, Nishikawa discloses the structure of the liquid crystal display capable of being controlled by a "special games control device" (i.e. a portion or program within the game controller) for providing a special games state under a predetermined condition, where the attraction control device controls the shielding device during the special gaming state to display such arrangements as a bonus game (i.e. a special game), overtop the variable display device.

Claim 22: Nishikawa discloses the attraction control device for controlling the shielding device and attraction device as indicated above, thus, for purposes of patentability the Examiner must show apparatus claims are structurally met by the prior art. Thus, the Examiner submits that the above discussion of Nishikawa disclose the attraction control device, shielding device, and attraction image display device, and any such use as recited in claim 22 is considered functional language. MPEP 2114 discloses that an apparatus claim

must be distinguished from the prior art in terms of structure rather then function. Therefore, the prior art of Nishikawa properly anticipate the structure of claim 22, and the structure is considered capable to perform the disclosed functions. An "apparatus claim" analysis as described above is applicable for all of claims 17-22, as each of claims 17-22 are apparatus claims where the prior art is only required to meet structural rather then function.

Response to Arguments

Applicant's arguments with respect to claims 17-22 have been considered but are moot in view of the new ground(s) of rejection. The rejection based upon 35 U.S.C. 102 as being anticipated by Nishikawa has been updated into a 35 U.S.C. 102 rejection as being obvious over Nishikawa. Any such applicable response is incorporated in the updated rejections above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert Pezzuto
Supervisory Patent Examiner
Art Unit 3714

M.B.S.